

REMARKS/ARGUMENTS

The Office Action mailed April 18, 2003, has been received and reviewed. Claims 61 through 71 are currently pending in the application. Claims 61 through 71 stand rejected. In view of the remarks made herein, applicants respectfully request reconsideration of the application.

35 U.S.C. § 251 Rejections

Reissue Declaration

Claims 61 through 71 stand rejected under 35 U.S.C. § 251 as being based upon a defective reissue declaration. Specifically, the Examiner states that the errors which are relied upon to support the instant reissue application have been corrected by the reissue patent Re38,049. Applicants respectfully disagree with the Examiner's rejection. Reissue patent Re38,049 corrected some of the errors from the original patent, but not all such errors were corrected in reissue patent Re38,049. This is demonstrated by the fact that claims 61-71 pending in the present reissue application were also presented (as claims 61-62, 66-70, and 74-77) in the as-filed patent application leading to the Re38,049. As the Examiner is aware, the Director may issue several reissued patents for separate parts of the thing patented upon demand of the applicant and payment of the appropriate fees. *See* MPEP 1401 and 35 U.S.C. 251.

Additionally, 35 U.S.C. 251 permits "multiple reissue patents to issue even where the multiple reissue patents are not for 'distinct and separate parts of the thing patented.' . . . [and] prosecution of a continuation of a reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation complies with the rules for reissue." MPEP 1451 (pg. 1400-54; 8th Ed.).

The reissue oath filed with patent Re38,049, which is the parent application upon which the present continuation is based and which also included the subject matter of pending claims 61-71, was accepted by the Examiner during the prosecution of patent Re38,049 and has been filed in the pending case. Thus, the description of the error in the oath is not one that was corrected by the reissue patent Re38,049 because: 1) the claims have different scopes and limitations and are not identical; 2) the pending application was filed during the pendency of

Re38,049 and would not have corrected the error at the time of filing; 3) the reasoning for the error was acknowledged by the Examiner as being proper in view of claims 61-71 (claims 61-62, 66-70, and 74-77 of Re38,049); and 4) there is no prohibition multiple reissue applications having separate claims for different or similar subject matter.

In view of the foregoing, applicants respectfully request withdrawal of the present rejection.

Recapture

Claims 61 through 71 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicants respectfully traverse the Examiner's rejection.

As stated in MPEP 1412.02, “[a] reissue will not be granted to ‘recapture’ claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).” (emphasis added). MPEP 1412.01 goes on to describe the “two step test for recapture” and describes the second step (determining whether subject matter has been surrendered) as:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. See MPEP § 706.02(I)(1) with respect to amendments made to distinguish the claimed invention from 35 U.S.C. 102(e)/ 103 prior art which was commonly owned or assigned at the time the invention was made.

The examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. The record of the original

application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered.

See MPEP 1412.02 at pg. 1400-13 (8th Ed.) (emphasis added). As noted in the foregoing sections of the MPEP, the analysis of whether or not a recapture has occurred must be made in view of the prosecution history of the original application from which the reissue or reissues are filed. In contrast, the Examiner has based the Section 251 rejections on a recapture of material allowed in a copending, related reissue application. Applicants respectfully contend that such a rejection has no support and is inappropriate.

In view of the foregoing, applicants respectfully request withdrawal of the present rejection.

CONCLUSION

Claims 61 through 71 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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